

## REMARKS

Entry of the foregoing and further and favorable reconsideration of the subject application are respectfully requested, in light of the following remarks pursuant to and consistent with 37 C.F.R. §1.112.

By the foregoing amendment, claims 25, 27, 30, 31 and 32 have been canceled without prejudice or disclaimer to the subject matter recited therein. Applicants are considered pursuing the subject matter of cancelled claims 25, 27, 30, 31 and 32 in a divisional application. Further, claims 23, 24 and 26 have been amended to further clarify Applicants' invention. Support for the amendments can be found throughout the specification. No new matter has been added.

### **I. Claim Objections**

Claims 24 and 26 have been objected to for allegedly being in improper dependent form. To expedite prosecution, Applicants have rewritten claims 24 and 26 in independent form.

### **II. Rejections Under 35 U.S.C. § 101**

Claims 27, 30-31 have been rejected under 35 U.S.C. § 101 as allegedly reciting a use without setting forth any steps involved in the process. This rejection has been rendered moot in view of the cancellation of claims 27, 30 and 31.

### **III. Rejections Under 35 U.S.C. § 112**

Claims 23-27 and 30-32 have been rejected under 35 U.S.C. § 112, first paragraph, because the specification, while being enabling for using polypeptides of SEQ ID NO:238, allegedly does not provide enablement for polypeptides which are 80%, 90% or partial SEQ ID NO:238 sequences. A portion of this rejection has been rendered moot in view of the cancellation of claims 25 and 27-32. However, to the extent that this rejection may apply to claims 23, 24 and 26, Applicants respectfully traverse this rejection.

The ultimate question is whether or not the specification contains a sufficiently disclosure to enable one having ordinary skill in the relevant field to practice the invention claimed therein without the exercise of undue experimentation. *See, e.g., Ex Parte Forman*, 230 U.S.P.Q. 546, 547 (PTO Bd. App. & Int. 1986). That some experimentation is necessary does not preclude enablement unless the amount of experimentation is unduly extensive. *See, e.g., U.S. v. Telectronics, Inc.*, 8 U.S.P.Q. 2d 1217, 1222 (Fed. Cir. 1988).

The Examiner has stated that the specification does not teach the skilled artisan how to use sequences which are similar to SEQ ID NO:238 (*i.e.*, sequences that are 80% and 90% homologous to SEQ ID NO:238) and that the skilled artisan would be required to perform undue experimentation on encompassed variants of SEQ ID NO:238 to determine whether the variant sequences are also overexpressed in cancerous tissues. Applicants respectfully disagree.

Applicants submit that it is well known in the art what is meant by homology and it is well known how one would determine if an isolated peptide is 80% or 90% homologous to SEQ ID NO:238. Further, Applicants submit that it is known in the art how to test for overexpression of a peptide (the present specification also provides a detailed description of how to test for overexpression of a peptide-see, in particular, the examples and the figures). Thus, undue experimentation would not be required to practice the claimed invention. The burden is on the U.S. Patent and Trademark Office to offer reasons or evidence establishing that despite the foregoing undue experimentation is required.

Accordingly, Applicants respectfully request withdrawal of the rejection of claims 23-27 and 30-32 under 35 U.S.C. § 112, first paragraph.

Claims 30-32 have been rejected under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. This rejection has been rendered moot in view of the cancellation of claims 30-32.

Claims 23-27 and 30-32 have been rejected under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

The Examiner has stated that claim 23 lacks adequate description for a partial sequence of SEQ ID NO:238 which is embedded within a larger polypeptide sequence and that the specification fails to describe a portion of SEQ ID NO:238 embedded within a larger polypeptide.

This rejection has been rendered moot in view of the cancellation of claims 25 and 27-32 and the amendments to claims 23, 24 and 26. Specifically, Applicants have amended claim 23 to clarify that the polypeptide sequence comprises the sequence of SEQ ID NO:238.

Accordingly, Applicants respectfully request withdrawal of the rejection of claims 23-27

and 30-32 under 35 U.S.C. § 112, first paragraph.

Claims 23-27 and 30-32 have been rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

The Examiner has stated that it is unclear whether the claims are directed to polypeptide partial sequences comprising SEQ ID NO:238 or whether the claim is directed to the partial sequence consisting of SEQ ID NO:238 or whether the claim is directed to fragments of SEQ ID NO:238 which are partial polypeptide sequences.

This rejection has been rendered moot in view of the cancellation of claims 25 and 27-32 and the amendments to claims 23, 24 and 26. Specifically, Applicants have amended claim 23 to clarify that the polypeptide sequence comprises the sequence of SEQ ID NO:238.

Accordingly, Applicants respectfully request withdrawal of the rejection of claims 23-27 and 30-32 under 35 U.S.C. § 112, second paragraph.

### **III. Rejections Under 35 U.S.C. § 102**

Claims 23-24, 26-27 and 30-32 have been rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Ni et al. (U.S. Patent No. 6,174,992) and under 35 U.S.C. § 102(b) as allegedly being anticipated by Ni et al. (WO 97/34997). Applicants respectfully traverse this rejection.

It is well settled law that to anticipate a claim, a single reference must teach each and every element of the claim. See *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986); *Atlas Powder Co. v. E.I du Pont De Nemours & Co.*, 750 F.2d 1569, 1574, 224 U.S.P.Q. 409, 411 (Fed. Cir. 1984).

The Examiner has stated that Ni et al. discloses a sequence which is 100% identical to amino acids 14-108 of SEQ ID NO:238 of the present invention, and that because this sequence is a partial sequence of SEQ ID NO:238, the sequence of Ni et al. anticipates the claimed invention.

This rejection has been rendered moot in view of the cancellation of claims 25 and 27-32 and the amendments to claims 23, 24 and 26. Specifically, Applicants have amended claim 23 to clarify that the polypeptide sequence comprises the sequence of SEQ ID NO:238. Ni et al. does not teach the entire sequence of SEQ ID NO:238 and thus cannot anticipate the claimed invention.

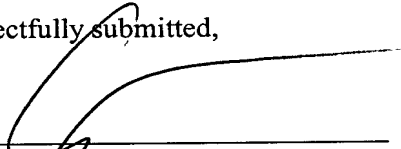

Accordingly, Applicants respectfully request withdrawal of the rejection of claims 23-24, 26-27 and 30-32 under 35 U.S.C. §§ 102(b) and 102(e).

From the foregoing, favorable action in the form of a Notice of Allowance is respectfully requested and such action is earnestly solicited.

In the event that there are any questions relating to this application, it would be appreciated if the Examiner would telephone the undersigned attorney concerning such questions so that prosecution of this application may be expedited.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

  
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**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

23. (Amended) [Polypeptide partial sequences according to sequences Seq. ID Nos. Seq. 142-528 and Seq. ID Nos. Seq. 561-575, 577-625, and 630-635] A polypeptide sequence comprising SEQ ID NO:238.

24. (Amended) [Polypeptide partial sequences according to claim 23,] A polypeptide with at least 80% homology to [these] the [sequences] sequence of SEQ ID NO:238.

26. (Amended) [Polypeptide partial sequences according to claim 23,] A polypeptide with at least 90% homology to [these] the [sequences] sequence of SEQ ID NO:238.